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REMARKS

The amendments and remarks herein are presented in favor of patentability and place this application in condition of allowance. Such action is respectfully requested.

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In response to Examiner's 35 U.S.C. 102(b) rejection over Chao, U.S. Patent No. 6,109,747, Applicant has canceled claims 10-13. Thus, the 102(b) rejection in view of Chao is now moot.

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Examiner has also rejected claims 1-9 and 14-26 under 35 U.S.C. 103(a) as being unpatentable over Chao (6,109,747). The 103(a) rejection is respectfully traversed.

35 U.S.C. § 103(a) states,

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[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

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(Emphasis added.)

In applying § 102(b), MPEP § 706.02(a) instructs, "[i]n a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The

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5 modification must be one which would have been obvious to one of
ordinary skill in the art at the time the invention was made."
MPEP §706.02(a) (page 700-21).

Examiner states that Chao discloses a grip extension 24
10 having a flange 25 downward with a magnet 26 whereas the claimed
invention claims a grip extension having a flange upward with a
magnet. Examiner further reasoned that the difference between
the claimed invention and Chao is the flange, i.e., oriented
upward versus downward, respectively. Examiner concluded that
15 although Chao does not teach the exact configuration as claimed
by the Applicant, the configuration differences are considered
obvious design choices and are not patentable unless unobvious
or unexpected results are obtained from these changes. Examiner
further noted, "[i]t appears that these changes produce no
20 functional differences and therefore would have been obvious."

Applicant respectfully disagrees with the reasoning of the
Examiner as to the obviousness of Applicant's invention. First,
the novel feature of applicant's invention is the mounting of
25 auxiliary eyeglasses on conventional eyeglasses with the sole
support being magnets oriented to provide maximum magnetic
attraction to hold the auxiliary eyeglasses on the conventional
eyeglasses.

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The possibility of mounting auxiliary frames on primary eyeglasses with the sole support being provided by mutually attractive magnets was overlooked and is not taught by Chao. Chao states, "[t]he primary objective of the present invention is to provide an auxiliary frame for attaching typical spectacle frame having no magnets therein." Col. 1, lines 23-25. The stated objective of Chao teaches away from attachment of auxiliary to primary frame via magnets alone, as is done by the Applicant.

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Chao specifically requires the use of a mechanical support member (arm 24) to hook the auxiliary frame onto the primary frame. In fact, the Chao reference essentially teaches that magnets alone are insufficient to hold the auxiliary eyeglasses on conventional frames because Chao only teaches that the use of magnets "may further solidly secure the auxiliary frame 20 to the primary frame 10." The phrase "further secure" underscores the importance of arm 24 extending over the bridge 11 and flange 25 protruding downward, in creating a hook-type connection. This teaches away from the Applicant's under and upward connection that does not depend on any hooks between the two frames and solely uses magnets to hold the two frames together.

5 Further, Chao's description of the main distinguishing
characteristic of his invention can be easily seen to be
teaching away from the Applicant's invention:

10 An auxiliary frame 20 for supporting auxiliary lenses
91 and for disposing in front of the primary frame
includes a bridge 21 and two extensions 22 disposed in
the side portions and extended rearward for engaging
over the bridge 11 and the studs 12 of the primary
frame 10 respectively. The bridge 21 includes an arm
24 extended rearward. The extensions 22 and the arm 24
15 each includes a rear end having a flange 23, 25
dependent downward.

Col. 2, lines 49-54.

20 In addition, Chao specifically states,

25 It is to be noted that the flanges 23, 25 of the
extensions 22 and of the arm 24 are extended downward
for engaging with the studs 12 and the bridge 11 such
that the flanges 23, 25 themselves form a hook means
for securing the auxiliary frame 20 to the primary
frame 10. In addition, the magnets 14, 26 are disposed
laterally such that the flanges 23, 25 may further be
stably and solidly attracted and retained in place.

30 Col. 2, lines 62-67.

Thus, it is abundantly clear that Chao never thought that
magnets alone would be sufficient to hold auxiliary eyeglasses
on conventional eyeglass frames.

35 Chao does not stop there and provides even more disclosure
that teaches further away from the Applicant's invention:

5 It is further to be noted that the flanges 23, 25 may
also be used to hook to the typical eyeglasses having
no magnets engaged therein, such that the auxiliary
frame 20 may be attached to any of the typical
10 eyeglasses. Particularly, when the typical eyeglasses
are made of metal or other magnetic materials, the
magnets 26 of the auxiliary frame 20 may also be used
for attracting the typical eyeglasses and may also be
used for solidly securing the auxiliary frame to the
typical eyeglasses.

15 It is also to be noted that with only the arm 24 and
the magnet 26 therein, the auxiliary frame 20 may also
be solidly secured to the primary frame 10. Without
the arm 24 and without the magnets 26, the auxiliary
20 frame 20 may also be secured to the primary frame 10
by engaging the flanges 23 with the studs 12. The
provision of the magnets 26 and 14 may further solidly
secure the auxiliary frame 20 to the primary frame 10.

25 Col. 3, lines 1-17.

It is very clear from the Chao disclosure that the
construction described in Chao is limited to a construction
where the main force keeping the primary frame 10 and the
30 auxiliary frame 20 attached is the metallic flanges 23, 25 of
the primary frame's arms hooking over and around the nose bridge
11 of the auxiliary frame. In Chao, magnets 24, 26 only
"further" secure the two frames together. Thus, Chao does not
describe, and certainly does not suggest the attachment of the
35 two frames via magnets alone.

Essentially, not only does Chao fail to teach or suggest
the Applicant's construction, Chao instead teaches and suggests

5 a contrary construction, i.e., of using mechanical support as a primary force along with magnets, which provide further support. Therefore, if Chao's invention was patentable, so to should be the Applicant's invention.

10 The Examiner does not explain what motivation one would to make the changes considering the repeated emphasis on mechanical support provided by the hooking of arm 24 of auxiliary frame 20 onto the bridge 11 of the primary frame 10. The Board in Ex Parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) expressly held, "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of non-obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification to make the necessary changes in the referenced device." (Emphasis added)

Applicant can find no motivation in the Chao reference to use a flange that mounts the primary frame bridge from the bottom, using only magnets as the force holding the two frames together. Such motivation is particularly lacking in view of Chao's repeated emphasis on the structural support provided by

5 hooking between arm 24 and bridge 11. Thus, Chao actually
teaches away from and is contrary to the invention disclosed and
claimed by applicant. This fact is clear and is convincing
evidence of nonobviousness. Furthermore, the holding in Chicago
Rawhide also clearly requires a finding of non-obviousness in
10 this case.

One additional reason why Applicant's invention is novel
and non-obvious in view of Chao is that the bottom-mounting
design, permissible because of the unique construction disclosed
15 and claimed by the Applicant, is cosmetically superior to top
mounted magnetic eyewear, such as disclosed in Chao.

The reason it is cosmetically superior is because top
mounted magnetic eyewear disclosed in Chao exposes the arm 24 to
20 view when the auxiliary frame is attached to the primary frame.
The metallic arm of the auxiliary frame in Chao is typically
considered to be visually unattractive by users because it
extends over and around the nose bridge of the primary frame and
is in full view.

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The present invention solves this cosmetic problem through
a structural solution by having only magnets holding the
auxiliary frame and the primary frame together, and by having
the rearward-extending arm go under and behind the nose bridge,

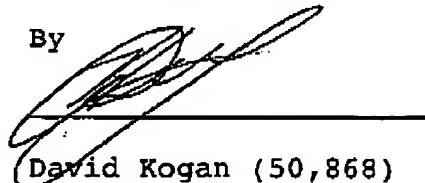
5 instead of over and behind the nose bridge, as in Chao. The
rearward-extending arm in the Applicant's invention is
practically not visible, as compared to Chao, when the auxiliary
lenses are attached to the primary lenses, so the problem of the
rearward arm being visually unappealing is solved. This
10 structural solution to a cosmetic problem is very important in
the eyewear industry because sales are largely based on
appearance and fashion. Such a structural solution to a
pressing problem in the fashion industry should be patentable.

15 Accordingly, applicant respectfully submits that the
pending claims clearly describe new and novel features, which
are not shown, taught, or remotely suggested by Chao, and should
be entitled to patent protection. Indeed the prior references
teach away from the arrangement disclosed, described and claimed
20 by Applicant. Thus, the 103(a) rejection of the pending claims
over Chao is improper and should be withdrawn.

Respectfully Submitted,

TROJAN LAW OFFICES

By



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